

Serial No. 09/877,974
Attorney Docket No.: SEDN/PRED008
Page 14 of 20

REMARKS

This response is intended as a full and complete response to the non-final Action mailed May 17, 2007.

Claims 100-119, 121-139, 141-151 and 153-168 are pending and rejected. By this response, Applicants have amended claims 100, 116-118, 121, 149, 156, 158, 159, 163, 166 and 168 and canceled claim 165.

In view of the above amendments and the following discussion, Applicants submit that none of the claims now pending in the application are anticipated or obvious under the respective provisions of 35 U.S.C. §§102 and 103. Thus, Applicants believe that all of these claims are now in allowable form.

It is to be understood that Applicants do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant response including amendments.

Applicants traverse all of the rejections in the Office Action mailed May 17, 2007 and respectfully request reconsideration and passage of the claims to allowance for the following reasons.

I. REJECTION OF CLAIM 165 UNDER 35 U.S.C. §101

Claim 165 is rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Responsive to the Examiner, the Applicants herein cancel claim 165. Thus, the rejection is now moot.

II. REJECTIONS UNDER 35 U.S.C. 103

A. Claims 121-128, 131-136, 141-146, 148, 149, 151, 153-161 and 163-168

The Office Action rejects claims 121-128, 131-136, 141-146, 148, 149, 151, 153-161 and 163-168 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,088,722 to Herz et al. ("Herz") in view of U.S. Patent No. 7,003,792 to Yuen et al. ("Yuen"). Applicants respectfully traverse the rejection.

575885-1

Serial No. 09/877,974
Attorney Docket No.: SEDN/PRED008
Page 15 of 20

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §2143.

The Office Action fails to establish a *prima facie* case of obviousness, because the combination of Herz and Yuen fails to teach or suggest all the claim elements for at least the following reasons.

Herz fails to teach erasing all of the gathered user-requested content information from iTV interactions once the profile of the user is developed, such that the user may not be matched to the gathered user-requested content information. The Examiner concedes this in the Office Action. (See Office Action, p. 3, ll. 20-22.) However, the Examiner alleges that Yuen bridges the substantial gap left by the Applicants' invention.

Yuen fails to bridge the substantial gap between Herz and Applicants' invention because Yuen also fails to teach or suggest erasing all of the gathered user-requested content information from iTV interactions once the profile of the user is developed, such that the user may not be matched to the gathered user-requested content information. Yuen teaches that if the raw information is erased, then the raw information is erased "on a periodic basis". (See Yuen, col. 4, ll. 10-11.) In contrast, the Applicants' invention teaches that the user-requested content information from iTV interactions is erased once the profile of the user is developed (i.e. immediately after). Consequently, the Applicants' invention teaches a more secure method because the Yuen teaches that the raw information is stored for a significantly longer period than the Applicants' invention (i.e. periodic, as taught by Yuen, versus once the profile of the user is developed, as taught by the Applicants' invention). Consequently, the method taught by Yuen provides a greater window of opportunity than the Applicants' invention to allow someone to match a user to the raw information, thereby compromising the user's privacy. Thus, Herz and Yuen, alone or in any permissible combination, fail to teach or suggest all of the limitations of the Applicants' invention.

575885-1

Serial No. 09/877,974
Attorney Docket No.: SEDN/PRED008
Page 16 of 20

Independent claims 149, 156, 158, 163, 166 and 168 contain similar limitations and are patentable over Herz and Yuen under 35 U.S.C. §103 for at least the same reasons that claim 121 is patentable over Herz and Yuen under 35 U.S.C. §103. Claims 122-128, 131-136, 141-146, 148, 151, 153-157, 159-161, 164-165 and 167 depend, directly or indirectly, from claims 121, 149, 156, 158, 163 and 166 and, thus, inherit the patentable subject matter of claims 121, 149, 156, 158, 163 and 166, while adding additional elements. Therefore, claims 122-128, 131-136, 141-146, 148, 151, 153-157, 159-161, 164-165 and 167 are also patentable over Herz and Yuen under 35 U.S.C. §103. Therefore, the rejection should be withdrawn.

B. Claims 100-103, 108-110, 116, 117, 129, 130, and 150

The Office Action rejects claims 100-103, 108-110, 116, 117, 129, 130, and 150 under 35 U.S.C. §103(a) as being unpatentable over Herz in view of U.S. Patent No. 5,659,350 to Hendricks et al. ("Hendricks") and Yuen. Applicants respectfully traverse the rejection.

The Office Action fails to establish a *prima facie* case of obviousness, because the combination of Herz and Hendricks fails to teach or suggest all the claim elements for at least the following reasons. For example, the combination fails to teach erasing all of the gathered user-requested content information from iTV interactions once the profile of the user is developed. Specifically, Applicants' independent claim 100 recites "A method for profiling iTV user, comprising: gathering user-requested content information from iTV interactions; correlating content-associated profile information from a rating service with the user-requested content information; developing a profile of a user based on developing a profile of a user based only on the iTV interactions; and erasing all of the gathered user-requested content information from iTV interactions once the profile of the user is developed."

As discussed above, Yuen also fails to bridge the substantial gap left by Herz and Hendricks because Yuen also fails to teach or suggest erasing all of the gathered user-requested content information from iTV interactions once the profile of the user is developed, such that the user may not be matched to the gathered user-requested content information.

Serial No. 09/877,974

Attorney Docket No.: SEDN/PRED008

Page 17 of 20

Independent claims 116, 117 and 118 contain similar limitations and are patentable over Herz, Hendricks and Yuen under 35 U.S.C. §103 for at least the same reasons that claim 100 is patentable over Herz, Hendricks and Yuen under 35 U.S.C. §103. Claims 101-103 and 107-110 depend, directly or indirectly, from claim 100 and, thus, inherit the patentable subject matter of claim 100, while adding additional elements. Therefore, claims 101-103 are also patentable over the combination of Herz and Hendricks under 35 U.S.C. §103.

Furthermore, as discussed above, independent claims 121 and 149 are patentable over Herz and Yuen under 35 U.S.C. §103. Claims 129, 130 and 150 depend, directly or indirectly, from claims 121 and 149, respectively, and thus, inherit the patentable subject matter of claims 121 and 149, while adding additional elements. Since the rejection of the corresponding independent claims under 35 U.S.C. §103 has been overcome, as described hereinabove, and there is no argument put forth by the Office Action that Hendricks supplies that which is missing from Herz and Yuen to render the independent claims unpatentable, these grounds of rejection cannot be maintained. Therefore, Applicants respectfully request that the Examiner's rejection be withdrawn. Therefore, claims 129, 130 and 150 are also patentable over the combination of Herz, Hendricks and Yuen under 35 U.S.C. §103. Therefore, the rejection should be withdrawn.

C. Claims 104-107

The Office Action rejects claims 104-107 under 35 U.S.C. §103(a) as being unpatentable over Herz, Hendricks and Yuen in view of U.S. Patent No. 5,223,924 to Strubbe ("Strubbe"). Applicants respectfully traverse the rejection.

Claims 104-107 depend, directly or indirectly, from claim 100 and, thus inherit the patentable subject matter of claim 100, while adding additional elements. Therefore, claims 104-107 are also patentable over Herz, Hendricks and Yuen under 35 U.S.C. §103. Furthermore, because Strubbe fails to teach developing a profile of a user based only on the profiles of the iTV programs accessed by the user, claims 104-107 are also patentable over the combination of Herz, Hendricks, Yuen and Strubbe under 35 U.S.C. §103. Therefore, the rejection should be withdrawn.

575885-1

Serial No. 09/877,974
Attorney Docket No.: SEDN/PRED008
Page 18 of 20

D. Claims 111-115

The Office Action rejects claims 111-115 under 35 U.S.C. §103(a) as being unpatentable over Herz, Hendricks and Yuen in view of U.S. Patent No. 5,848,396 to Gerace ("Gerace"). Applicants respectfully traverse the rejection.

Claims 111-115 depend, directly or indirectly, from claim 100 and, thus inherit the patentable subject matter of claim 100, while adding additional elements. Therefore, claims 111-115 are also patentable over Herz, Hendricks and Yuen under 35 U.S.C. §103. Furthermore, because Gerace fails to teach developing a profile of a user based only on the profiles of the iTV programs accessed by the user, claims 111-115 are also patentable over the combination of Herz, Hendricks, Yuen and Gerace under 35 U.S.C. §103. Therefore, the rejection should be withdrawn.

E. Claim 118

The Office Action rejects claim 118 under 35 U.S.C. §103(a) as being unpatentable over Herz and Yuen in view of Hendricks. Applicants respectfully traverse the rejection.

Independent claim 118 contains similar limitations and is patentable over Herz, Hendricks and Yen under 35 U.S.C. §103 for at least the same reasons discussed above that claim 100 is patentable over Herz, Hendricks and Yuen under 35 U.S.C. §103. Therefore, the rejection should be withdrawn.

F. Claim 119

The Office Action rejects claim 119 under 35 U.S.C. §103(a) as being unpatentable over Herz, Hendricks and Yuen in view of Strubbe. Applicants respectfully traverse the rejection.

Claim 119 depends from claim 118 and, thus inherits the patentable subject matter of claim 118, while adding additional elements. Therefore, claim 119 is patentable over Herz, Hendricks and Yuen under 35 U.S.C. §103. Furthermore, because Strubbe fails to teach developing a profile of a user based only on the profiles of the iTV programs accessed by the user, claim 119 is also patentable over the

Serial No. 09/877,974
Attorney Docket No.: SEDN/PRED008
Page 19 of 20

combination of Herz, Hendricks, Yuen and Strubbe under 35 U.S.C. §103. Therefore, the rejection should be withdrawn.

G. Claims 125, 126, 128, 142, 143, 148, 154, 157, 159-161, 164, and 165

The Office Action rejects claims 125, 126, 128, 140, 142, 143, 148, 152, 154, 157, 159-161, 164, and 165 under 35 U.S.C. §103(a) as being unpatentable over Herz and Yuen. Applicants respectfully traverse the rejection.

The Applicants respectfully submit that this appears to be an identical rejection as noted in Section A above. As such, the Applicants believe that this rejection is already addressed in Section A above. Therefore, for at least the same reasons discussed in Section A, the Applicants believe that claims 125, 126, 128, 140, 142, 143, 148, 152, 154, 157, 159-161, 164, and 165 are patentable over Herz and Yuen and respectfully request the rejection be withdrawn.

H. Claims 137-139 and 147

The Office Action rejects claims 137-139 and 147 under 35 U.S.C. §103(a) as being unpatentable over Herz and Yuen in view of U.S. Patent No. 6,005,597 to Barrett et al. ("Barrett"). Applicants respectfully traverse the rejection.

Claims 137-139 and 147 depend from claim 121 and, thus inherit the patentable subject matter of claim 121, while adding additional elements. Therefore, claims 137-139 and 147 are patentable over Herz and Yuen under 37 C.F.R. §103. Furthermore, because Barrett fails to teach developing a profile of a user based only on the profiles of the iTV programs accessed by the user, claims 137-139 and 147 are also patentable over the combination of Herz, Yuen and Barrett under 35 U.S.C. §103. Therefore, the rejection should be withdrawn.

I. Claim 162

The Office Action rejects claim 162 under 35 U.S.C. §103(a) as being unpatentable over Herz and Yuen in view of U.S. Patent No. 6,708,335 to Ozer et al. ("Ozer"). Applicants respectfully traverse the rejection.

Serial No. 09/877,974
Attorney Docket No.: SEDN/PRED008
Page 20 of 20

Claim 162 depends from claim 159 and, thus inherits the patentable subject matter of claim 159, while adding additional elements. Therefore, claim 162 is patentable over Herz and Yuen under 35 U.S.C. §103. Furthermore, because Ozer fails to teach developing a profile of a user based only on the profiles of the iTV programs accessed by the user, claim 162 is also patentable over the combination of Herz, Yuen and Ozer under 35 U.S.C. §103. Therefore, the rejection should be withdrawn.


CONCLUSION

Applicants believe that the claims are in condition for allowance. Accordingly, reconsideration and allowance are respectfully solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall or Jimmy Kim at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: 8/16/07



Eamon J. Wall, Attorney
Reg. No. 39,414
(732) 530-9404

Patterson & Sheridan, LLP
595 Shrewsbury Avenue, Suite 100
Shrewsbury, New Jersey 07702

575885-1